

Applicants: Gary Brian Evans, et al.
Appl. No.: 10/524,995
Filing Date: September 27, 2005

REMARKS

The Examiner indicated that Claims 1-28 were pending in the subject application. Applicants note that Claim 28 should have been previously canceled by a Preliminary Amendment filed on September 27, 2005. Claims 10 and 19 have been withdrawn by the Examiner as directed to non-elected subject matter. By this amendment, applicants have canceled Claims 10, 19 and 26 without prejudice or disclaimer, and confirm the cancellation of Claim 28 without prejudice or disclaimer. Claims 1, 11, 23-25 and 27 have been amended and new Claims 29-31 have been added. Support for Claim 29 can be found at least in Compound 8 on pages 12 and 17. Support for Claims 30 and 31 can be found at least in the paragraph bridging pages 21-22. Support for the remaining claim amendments can be found at least in the previous version of the claims.

The title has been amended as suggested by the Examiner.

Applicants maintain that the amendments do not raise an issue of new matter. Accordingly, entry of the amendments is respectfully requested.

Claim Objections

Claims 1-9, 11-18 and 20-28 are objected to as containing non-elected subject matter, specifically compounds of Formula (II) where $A = N$, and all the compounds of Formula (III). The claims have herein above been amended to remove non-elected subject matter. Accordingly, reconsideration and withdrawal of this objection are respectfully requested.

Objection to the Specification

The title is objected to as not descriptive after restriction. The title has been amended as suggested by the Examiner, thereby obviating this rejection.

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Rejections under 35 U.S.C. §112

1. Claims 25-28 are rejected under 35 U.S.C. §112, second paragraph, because the Examiner indicated that the specification does not set forth steps to determine how to identify a “disease or condition in which it is desirable to inhibit purine phosphoribosyltransferase, purine nucleoside phosphorylase, 5'-methylthio adenosine phosphorylase, 5'-methylthioadenosine nucleosidase and/or nucleoside hydrolase.” Claim 25 has hereinabove been amended to specify that the disease or condition is a cancer, a bacterial infection, a protozoal infection, a T-cell mediated disease or a transplant rejection. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

2. Claims 27 is rejected under 35 U.S.C. §112, second paragraph, because the Examiner considers that the term “arthritis” is indefinite. Applicants respectfully point out that, as noted by the Examiner, arthritis refers to inflammation of the joints, which can arise due to different causes. Accordingly, applicants maintain that the metes and bounds of the claim are clear and thus reconsideration and withdrawal of this rejection are respectfully requested.

3. Claims 1-9, 11-18 and 20-28 are rejected under 35 U.S.C. §112, second paragraph, because the Examiner indicated that the specification does not indicate what the possible substituents are in an “optionally substituted alkyl, aralkyl or aryl group.” Applicants note that an optional substituent in variable Q can be found at least in the Tables on pages 19 and 55 of the specification. In addition, examples of substitutents can be found in Formula (I), Formula (II) and Formula (III). Applicants maintain that one of ordinary skill in the art can determine that an alkyl, aralkyl or aryl group is

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substituted and thus that the metes and bounds of the claim are clear. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

4. Claim 24 is rejected under 35 U.S.C. §112, second paragraph, as being incomplete for not reciting an essential element, i.e. a carrier. Claim 24 has hereinabove been amended to recite a carrier, thereby obviating this rejection.

5. Claim 27 is rejected under 35 U.S.C. §112, second paragraph, because “transplant rejection” is not a disease. The claims have hereinabove been amended to refer to transplant rejection as a “condition.” Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

6. Claims 1-9, 11-18 and 20-28 are rejected under 35 U.S.C. §112, first paragraph, because the Examiner indicated that the specification is not enabling for making “esters” or “prodrugs” of the claimed compounds. The claims have hereinabove been amended to delete “esters” and “prodrugs” thereby obviating this rejection.

7. Claims 25-28 are rejected under 35 U.S.C. §112, first paragraph, as not enabled. Claim 25 has hereinabove been amended to recite:

A method of treating a subject having a disease or condition in which it is desirable to inhibit purine phosphoribosyltransferase, purine nucleoside phosphorylase, 5'-methylthio adenosine phosphorylase, 5'-methylthioadenosine nucleosidase and/or nucleoside hydrolase comprising administering a compound as claimed in claim 1 to the subject in an amount effective to inhibit purine phosphoribosyltransferase, purine

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nucleoside phosphorylase, 5'-methylthio adenosine phosphorylase, 5'-methylthioadenosine nucleosidase and/or nucleoside hydrolase, wherein the disease or condition is a cancer, a bacterial infection, a protozoal infection, a T-cell mediated disease or a transplant rejection.

Claim 25 is no longer directed to treating a disease or condition. Rather, the claim is directed to treating a subject having a specified disease or condition, where the treatment comprises administering to the subject an amount of a compound of claim 1 that is effective to inhibit purine phosphoribosyltransferase, purine nucleoside phosphorylase, 5'-methylthio adenosine phosphorylase, 5'-methylthioadenosine nucleosidase and/or nucleoside hydrolase. Dose information is provided on page 22 of the specification. Applicants maintain that the teaching of the specification is enabling for the skilled artisan to practice the invention of Claim 25 without undue experimentation. Claim 27 further limits Claim 25. Claims 26 and 28 have been canceled, thereby rendering the rejection moot with respect to those claims. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejection under 35 U.S.C. §101

Claim 28 is rejected for reciting a use without setting forth any steps in the process. Claim 28 has been canceled, thereby rendering this rejection moot.

Obviousness-type Double Patenting Rejection

Claims 1-9, 11-18, 20-23 and 28 are provisionally rejected over Claim 14 of copending U.S. Patent Application No. 10/543,380. Applicants note that Claim 14 of U.S. Patent Application No. 10/543,380 was canceled in an amendment dated October 10, 2007, thereby rendering this provisional rejection moot.

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Supplemental Information Disclosure Statement

This Supplemental Information Disclosure Statement is being filed to supplement the Information Disclosure Statement filed on October 12, 2005 in connection with the subject application.

In accordance with the duty of disclosure under 37 C.F.R. §1.56, applicants would like to direct the Examiner's attention to the references that are listed on the attached forms, PTO/SB/08A and PTO/SB/08B (4 pages). A copy of each non-U.S. patent publication is also attached hereto.

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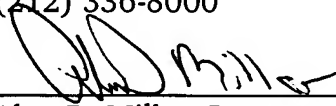
CONCLUSIONS

In view of the amendments and remarks made hereinabove, reconsideration and withdrawal of the objections and rejections set forth in the September 11, 2007 Office Action and passage of the pending claims to allowance are respectfully requested. If there are any minor matters preventing the allowance of the subject application, the Examiner is requested to telephone the undersigned attorney.

A check for \$300.00 is enclosed for the \$120.00 fee for a one month extension of time and for the \$180.00 fee for submitting an Information Disclosure Statement. No additional fee is deemed necessary in connection with the submission of this reply. However, if any other fee is required with this reply or to maintain the pendency of the subject application, authorization is hereby given to withdraw the amount of any such fee from Deposit Account No. 01-1785.

Respectfully submitted,
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Dated: January 11, 2008
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By 
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